

REMARKS

Applicant's Counsel thanks Examiner Zheng for the courtesies extended during the telephone conference held June 13, 2008.

Claim 1-7 are pending and stand rejected. Specifically, the Examiner rejects claim 1-7 for allegedly failing to comply with the written description requirements. The Examiner also rejects claims 1 and 4-6 as allegedly obvious over WO 02-07902 to *Dupart* et al. ("*Dupart*"), in view of Japanese Patent No. JP 8-983 (*JP-983*) and further in view of Patent No. 5,704,995 to *Bradley*. Claims 2-3 and 7 stand rejected as allegedly unpatentable over *Dupart*, in view of *JP-983* and *Bradley* and further in view of U.S. Patent No. 4,243,434 to *Hartley*. For the reasons that follow, the rejections should be reconsidered and withdrawn.

Rejection under § 112, First Paragraph

The Examiner rejects the claimed recitation of "transparent conversion coating" for allegedly lacking written description. This rejection should be reconsidered and withdrawn.

Our specification, as filed, noted not only the environmental advantages of a trivalent chromate coating over the conventional black hexavalent chromate coatings and the desire to have a black coating on Page 14, but further notes in Lines 18-20 that a glossy black coating is formed on the final product indicative of a transparent final coating with silica.

The Declaration of Yoshitaka Asou and the specimens of Exhibit B and Exhibit B+C of coated screws disclose the fact that the second coating step shown in Exhibit B+C does not alter the initial black coating of trivalent chromium and iron components. Additionally, the amendment of our claims removes the possible broad interpretation of additional unclaimed elements.

As discussed in Applicant's previous communications, a solution containing inorganic salt, organic acid, trivalent chromium and silica is inherently transparent. This fact is evident from the published literature, including Japanese Examined Patent Application Publication No. S42-14050 ("Japanese Patent Publication '14050"), which was submitted to the Office under the cover of Applicant's IDS, filed January 30, 2008.

The Japanese Patent Publication '14050 concerns forming a transparent surface. The reference states that if chromic acid or silic acid sol (SiO_2 = silica) is overly concentrated or added, coloring or a strain is generated. The explanation clarifies that if the appropriate amount of chromic acid or silic acid sol is added, a coating can be obtained that does not have the coloring or the stains. Accordingly, the claimed solution is inherently transparent.

Since the claimed solution is inherently transparent and because Applicant need not disclose *in haec verba* product characteristics that are inherent or implied (see MPEP §2163), Applicant submits that the specification supports the claimed recitation: "transparent conversion coating." For at least these reasons, the §112 rejection should be withdrawn.

Obviousness rejections

The Examiner alleges that Claims 1-7 are obvious over *Dupart*, in view of JP-983 and other tertiary references. While Applicant disagrees with the grounds of the rejection, to expedite prosecution Applicant has amended the independent claims to recite a method "consisting of" the recites steps.

As amended, the claims recite a method for providing a transparent coating from a "solution of inorganic salt and organic acid containing trivalent chromium and silica as main ingredients." The references do not disclose nor suggest a transparent coating as claimed. As noted by the Examiner at Page 4 of the Office Action, *Dupart* does not disclose a transparent

conversion coating. The reference JP-983 discloses a conversion coating solution containing phosphoric acid and metal ions such as cobalt. The independent claims are limited to the recited ingredients and because JP-983 requires the addition of phosphoric acid and metal ions, the references fail to render the claimed invention unpatentable. The tertiary references fail to cure this deficiency.

Accordingly, applicant respectfully submits that the claims are now in condition for allowance.

Applicant's Declaration

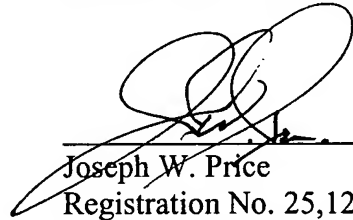
Submitted on an even date herewith is Applicant's Declaration under 37 C.F.R. §1.32 which provides additional reasons for patentability. The Declaration states that comparative specimen were prepared using the claimed method (specimen bag labeled "B+C") and the method of the closest known prior art (specimen bag labeled "B"). A visual comparison of the two specimen show that the claimed method forms a clear or transparent coating over the specimen which is not seen in the sample prepared in accordance with the conventional methods.

Having addressed the rejections of the pending Office Action, Applicant respectfully submits that the application is now in condition for allowance and an early notification of the same is requested.

If there are any questions with regards to this submission, the undersigned attorney would appreciate a telephone conference.

Very truly yours,

SNELL & WILMER L.L.P.



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